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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dale R. Peterson

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EXAMINER

SELF, SHELLEY M

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/669,109		PETERSON, DALE R.	
	Examiner		Art Unit	
	Shelley Self		3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10, 12, 13, 17-19, 21-33 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-10, 12, 13, 17-19, 21-33 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3725

DETAILED ACTION

Response to Amendment

The amendment filed on November 21, 2005 has been considered but is ineffective to overcome the prior art reference.

Upon further review, the indication of allowable subject matter noted in the previous Office Action is withdrawn and an action on the merits follows.

Specification

The amendment filed November 21, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "said depth guides being positioned on said face of said grinding teeth at different locations than said grinding teeth" (clms. 26, 27, 31-33).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26, 27 and 31-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains,

Art Unit: 3725

or with which it is most nearly connected, to make and/or use the invention. Neither the originally filed written disclosure nor the drawings provide support for “*depth guides being positioned on said face of said grinding teeth at different locations than said grinding teeth*”.

How it is possible for the depth guides to be positioned on the face of the teeth and also at different locations than said teeth. The specification fails to provide support for this limitation. Accordingly the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5-9, 13, 17-19 and 25, are rejected under 35 U.S.C. 102(b) as being anticipated by Paumier (6,435,234). With regard to claim 5, Paumier discloses a stump grinding machine that is configured to mount to a powered vehicle (fig. 1) said stump grinding machine being operable to grind a stump and comprising: a disc mount (24) mounted to a mounting portion of the powered vehicle (fig. 1) and pivotable about a generally horizontal axis (figs. 1, 3 and a grinding disc (14) mounted to said disc mount and rotatable about a disc axis (fig. 1, 3, 4), said grinding disc having a plurality of teeth (fig. 3) on a face of said disc, said grinding disc (14) being rotatably drivable by a rotational drive device (52) connected to said grinding disc (14) and to a power source of the powered vehicle (col. 4, lines 11-15), said disc mount being pivotable about said generally horizontal axis (figs. 1, 2) to arcuately move said grinding disc as said grinding

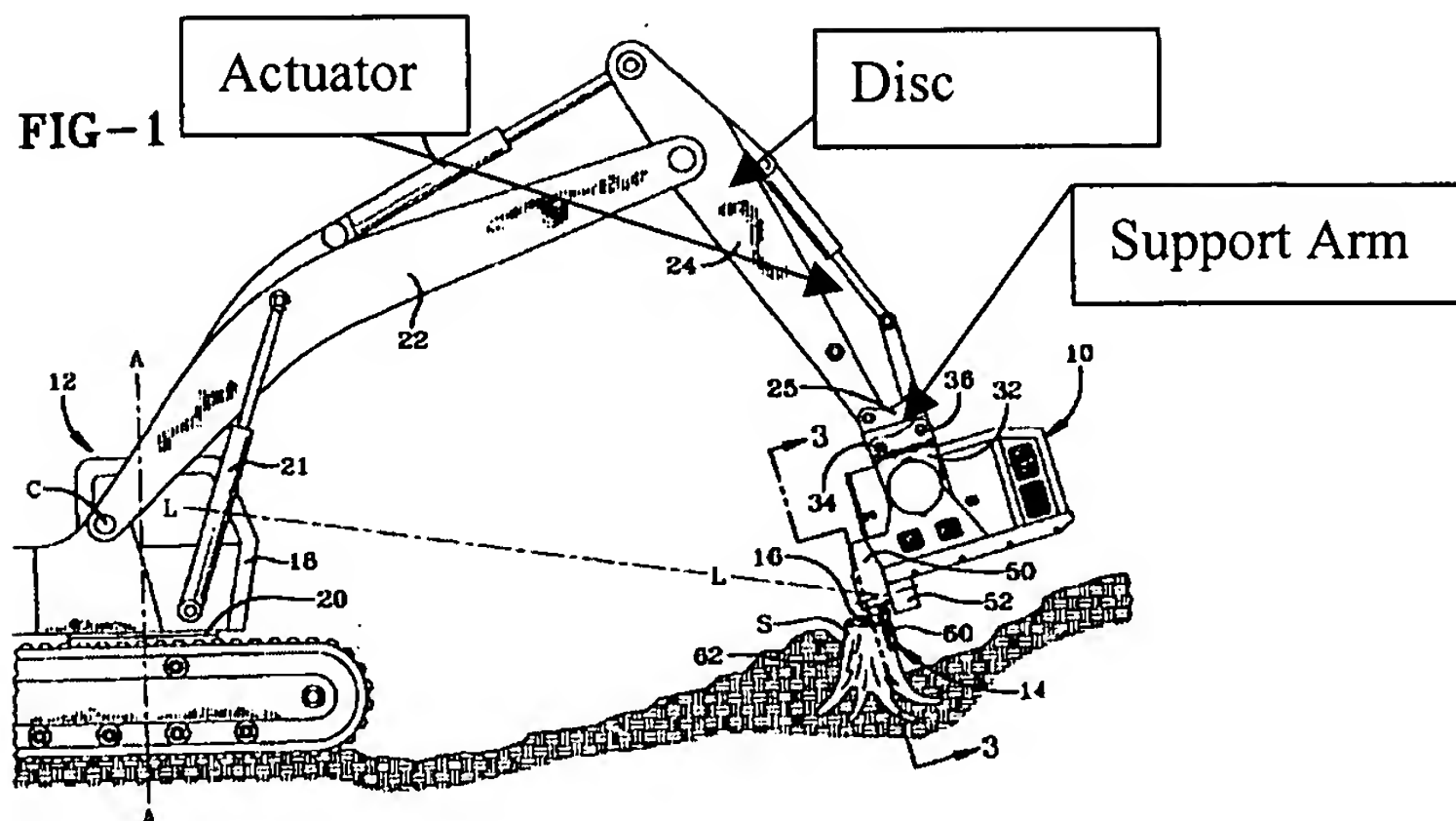
Art Unit: 3725

disc is rotatably driven via said rotation drive device to grind a stump; and a mounting frame (22) configured to connect to the mounting portion of the powered vehicle (fig. 1) and to extend generally horizontally therefrom, said disc mount (24) being pivotally mounted (fig. 1) to said mounting frame (22) wherein said mounting frame (22) comprises a base portion (fig. 1) attachable to the powered vehicle and a support portion (23) mounted at one end of said base portion (fig. 1) and extending generally horizontally from said base portion (fig. 1), said disc mount (24) being pivotally attached to an opposite end of said support portion from said base portion (fig. 1).

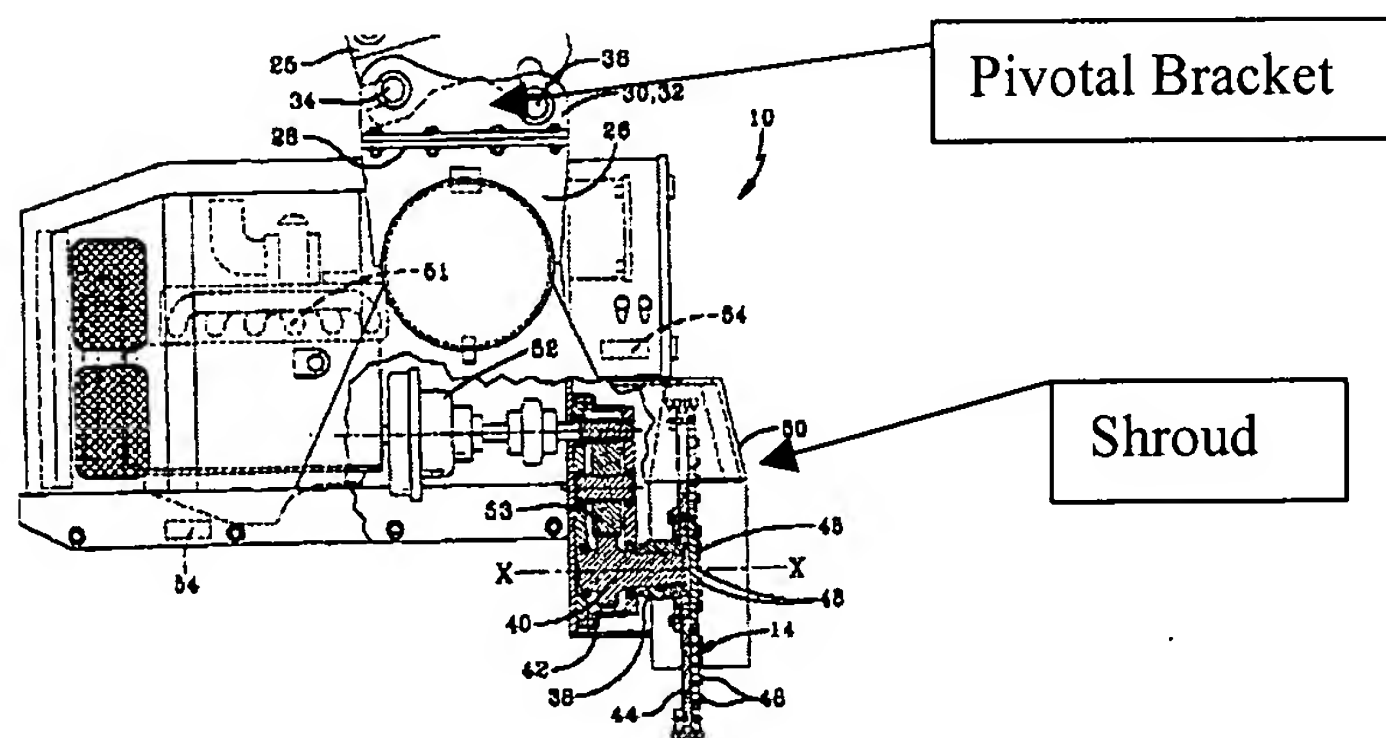
With regard to claims 6 and 37, Paumier discloses wherein said support portion (23) is pivotally mounted to said base portion (fig. 1) and is pivotable about a generally vertical axis.

With regard to claim 7, Paumier discloses wherein said support portion is pivotable about said generally vertical axis via a first actuator (21) and said disc mount is pivotable about said generally horizontal axis via a second actuator (fig. 1; Examiner notes, actuate above disc mount 24 connected to grinder 10).

With regard to claims 8 and 9, Paumier discloses wherein said face of said grinding disc (14) comprises a front face that is facing generally toward the powered vehicle when said stump grinding machine is connected to the powered vehicle a rear a face that is facing generally away from the powered device when said stump grinding machine is connected to the vehicle. (fig. 1, 4).



With regard to claim 13, Paumier discloses a shroud (50) and a mounting bracket (fig. 4).



With regard to claim 17, Paumier discloses said mounting bracket is pivotably about said horizontal axis in response to an actuator (fig. 1) that is connectable between the support arm and said mounting bracket (fig. 1).

Art Unit: 3725

With regard to claim 18, Paumier discloses said disc mount is biased toward an initial orientation, said disc mount pivoting about said horizontal axis away from said initial orientation in response to said grinding disc (14) being moved into engagement with a stump (fig. 1) via the vehicle (fig. 1).

With regard to claim 19, Paumier discloses wherein the disc mount is biased to urge said grinding disc into and at least partially through the stump (fig. 1) to grind the stump after the vehicle is stopped (fig. 1).

With regard to claim 25, Paumier discloses said teeth (48) spaced radially along said face of said grinding disc (fig. 3).

Additionally, claims 5-7 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Maroney(5,829,497). Maroney discloses a stump grinding machine that is configured to mount to a powered vehicle (col. 2, lines 16-21) said stump grinding machine being operable to grind a stump and comprising: a disc mount (26, 27) mounted to a mounting portion of the powered vehicle (fig. 1) and pivotable about a generally horizontal axis (figs. 3); and a grinding disc (45) mounted to said disc mount and rotatable about a disc axis (fig. 2), said grinding disc having a plurality of teeth (51; fig. 2) on a face of said disc, said grinding disc (45) being rotatably drivable by a rotational drive device (col. 3, lines 28-40) connected to said grinding disc (45) and to a power source of the powered vehicle (col. 3, lines 28-30), said disc mount being pivotable about said generally horizontal axis (figs. 3-5) to arcuately move said grinding disc as said grinding disc is rotatably driven via said rotation drive device to grind a stump; and a mounting frame (3) configured to connect to the mounting portion of the powered vehicle (fig. 1) and to extend generally horizontally therefrom, said disc mount (26, 27) being pivotally

Art Unit: 3725

mounted (col. 3, lines 6-26) to said mounting frame (3) wherein said mounting frame (3) comprises a base portion (fig. 1) attachable to the powered vehicle and a support portion (15) mounted at one end of said base portion (fig. 1) and extending generally horizontally from said base portion (fig. 1), said disc mount (26, 27) being pivotally attached to an opposite end of said support portion from said base portion (fig. 1).

With regard to claims 6 and 37, Maroney discloses wherein said support portion (15) is pivotally mounted to said base portion (fig. 1) and is pivotable about a generally vertical axis.

With regard to claim 7, Maroney discloses wherein said support portion is pivotable about said generally vertical axis via a first actuator (11) and said disc mount is pivotable about said generally horizontal axis via a second actuator (64).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 10, 12, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paumier (6,435,234) in view of Maroney (5,829,497). With regard to claims 2 and 36, Paumier discloses a stump grinding machine that is configured to mount to a powered vehicle (fig. 1), said stump grinding machine being operable to grind a stump and comprising: a disc mount (22) mounted at a mounting portion of the powered vehicle and pivotable about a generally horizontal axis (fig. 2); and a grinding disc (14) rotatably mounted to said disc mount and rotatable about a

Art Unit: 3725

disc axis, said grinding disc having a plurality of grinding teeth (48) on a face of said disc (fig. 4), said grinding disc being rotatably drivable by a rotational drive device (38, 51) connected to said grinding disc and to a power source of the powered vehicle (col. 4, lines 5-28), said disc mount being pivotable about said generally horizontal axis to arcuately move said grinding disc as said grinding disc is rotatably driven via said rotational drive device to grind a stump.

Paumier does not disclose said rotation drive device comprises a telescopic drive shaft. Maroney teaches in closely related art a stump grinder configured to be connected/mounted to a tractor/vehicle wherein the rotation drive device of the stump grinder comprises a telescopic drive shaft (34; figs. 3-5; col. 3, lines 22-30). Maroney teaches this construction for improved versatility and maneuverability in grinding stump. Because the references are from a closely related art and deal with a similar problem (i.e.; grinding stump via vehicle mounted disc grinder) it would have been obvious at the time of the invention to one having ordinary skill in the art to replace, Paumier's non-telescopic drive shaft with a telescopic drive shaft for improved versatility and maneuverability as taught by Maroney.

With regard to claim 3, Paumier discloses a mounting frame (fig. 1) configured to connect to the mounting portion of the powered vehicle (fig, 1) and to extend generally horizontally therefrom, said disc mount being pivotally mounted (C) to said mounting frame. Examiner notes that because the mounting portion has a substantial height and width, the portion too has both vertical and horizontal extension and thus *extends generally horizontally*.

With regard to claim 4, Paumier discloses the mounting frame (fig. 1) configures to be cantileverely supported. Examiner understands cantileverely support to be "supported at only one end."

Art Unit: 3725

With regard to claim 10, Paumier discloses said stump grinding machine (10) is configured to mount to a powered tractor (fig. 1).

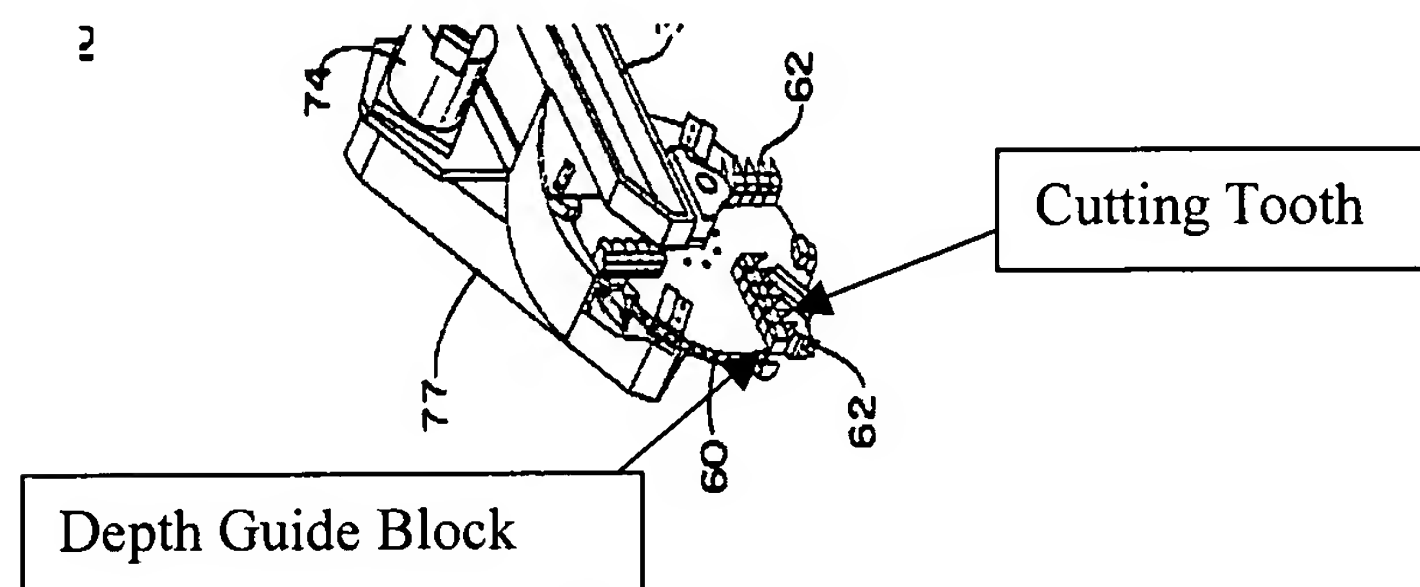
With regard to claim 12, Paumier discloses said disc mount (22) is pivotally mounted to the mounting portion (fig. 1) of a support arm extending from the powered vehicle (12) and defining the mounting portion of the powered vehicle. See fig. 1

Claims 17, 21, 22, 24, 28, 30, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paumier (6,435,234) alone or in view of Bowling (6,021,825). With regard to claims 21, 22, 24, 30 and 38, Paumier discloses said grinding disc includes a plurality of depth guides position on said face of said grinding disc, said depth guides limiting the depth of cut of said grinding teeth as the grinding disc is rotated and engaged with the stump (S). Examiner notes that the non-cutting (perpendicular edge to the cutting edge) of the teeth (48) act as a depth guide, i.e. the teeth are prohibited from cutting any further into the stump (S) than the overall length of the cutting teeth, thus the length of the cutting teeth act as a guide for cutting depth of the teeth (48).

Moreover, Bowling teaches in a similar art the use of a stump-grinding machine (fig. 1) having a rotatable grinding disc (60) wherein both cutting teeth and depth guides (62) are spaced on a face of grinding disc (60). Bowling teaches this construction so as to efficiently grind a stump. Because the references are from a similar art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Paumier's cutting teeth (48) with cutting teeth and depth guides as taught by Bowling so as to efficiently grind a stump.

Art Unit: 3725

As to the adjustability of the depth guides (clms. 17, 28, 39). Examiner notes the teeth (48) to be replaceable, i.e.; adjustable due to wear (col. 3, lines 41-47), because as noted above, the non-cutting (perpendicular edge to the cutting edge) of the teeth (48) act as a depth guide, the replacement of any tooth (48) will lend to "adjustability":



Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paumier (6,435,234) alone or in view of Bowling (6,021,825) as applied to claim 28 above, and further in view of Ver Ploeg (3,797,544). Neither Paumier nor Bowling discloses a shim for adjusting the cutting depth of the tool. Ver Ploeg teaches in a closely related art a stump-grinding machine (fig. 1) wherein a cutter disc has a plurality of cutting teeth (40) mounted on a face of the disc (10; fig. 2). Further Ver Ploeg teaches the use of a shim (72; fig. 9) so as to adjustably mount the cutting tooth (40). Because the shim (70) and non-cutting edge act as a guide to the depth of the tooth (40) into the stump (fig. 1) Ver Ploeg teaches adjustability of depth guides for a stump-grinding machine. Because the references are from a closely related art and deal with a similar problem, i.e. stump cutting via a rotary cutting disc, it would have been obvious at the time of the

Art Unit: 3725

invention to one having ordinary skill in the art to provide either Paumier or Bowling with a shim as for improved cutting tool adjustability as taught by Ver Ploeg.

Response to Arguments

Applicant's arguments have been carefully considered but are moot in view of the new ground(s) of rejection.

As to Applicant's arguments that Bowling fails to teach or suggest a depth guide, this is not found persuasive. Bowling, like Paumier teaches a cutting tooth mounted to a rotary disc stump-cutting machine. Further, Bowling teaches a side of the cutting tooth having a non-cutting edge that non-cutting edge acts as a depth guide, in that once the stump incurs that edge, the cutting teeth can no longer cut within the stump, thus a depth-cutting guide.

Due to the newly applied reference(s) and new grounds of rejection this Office Action is made non-Final.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

March 20, 2006